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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/799,671

03/15/2004

Jari Mutikainen

47092.00075

8603

32294

7590

06/01/2009

SQUIRE, SANDERS & DEMPSEY L.L.P.

8000 TOWERS CRESCENT DRIVE

14TH FLOOR

VIENNA, VA 22182-6212

EXAMINER

LIU, BEN H

ART UNIT

PAPER NUMBER

2416

MAIL DATE

DELIVERY MODE

06/01/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b>	<b>Application No.</b> 10/799,671	<b>Applicant(s)</b> MUTIKAINEN ET AL.	
	<b>Examiner</b> BEN H. LIU	<b>Art Unit</b> 2416	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 11 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
 b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
 (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
 (b) ☐ They raise the issue of new matter (see NOTE below);  
 (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
 (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
 5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
 6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
 7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
 The status of the claim(s) is (or will be) as follows:  
 Claim(s) allowed: \_\_\_\_\_.  
 Claim(s) objected to: \_\_\_\_\_.  
 Claim(s) rejected: 1-12, 14-35, 37-43 and 45-59.  
 Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
 9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
 10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
 12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
 13. ☐ Other: \_\_\_\_\_.

/Ricky Ngo/  
 Supervisory Patent Examiner, Art Unit 2416

Continuation of 11. does NOT place the application in condition for allowance because:

The Applicant has submitted an after-final, proposed amendment which amends claims 1, 35, 43, and 54-58. The Applicant asserts that the amended claims are not taught by the cited prior art.

The Applicant argues, "Hyllander is completely silent with respect to any mechanism for transmitting a conference request to an application server." The Applicant further argues, "Nor does Hyllander's user terminal have any mechanism for receiving a temporary routing number for a conference call." In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

It is noted that Hyllander et al. disclose a telephony/Internet application server 11 that provides a connection between user terminal on a circuit-switched network and a terminal on a packet-switched network (see Hyllander et al., figure 2). The application server 11 receives a call request via SMS from the user terminal indicating the internet address of a desired callee (see Hyllander et al., column 2 lines 57-63). In response to the call request, application server 11 transmits a SMS that provides a telephone number used to temporarily route a call request (see Hyllander et al., column 3 lines 1-7). Chaney et al. disclose a conference server 152 that provides a conference service to users using Internet addresses (see Chaney et al., figure 8). The application server 11 as taught by Hyllander et al. can be coupled to the conference server 152 as taught by Chaney et al. to provide a packet-switched conference call service using a connection between a packet-switched network and a user terminal via a circuit-switched network.

Multiple user terminals as taught by Hyllander et al. can make an call request to a common callee in the packet-switched network. Each user terminal can transmit a conference request to an application server as recited by the independent claims by transmitting the Internet address of the desired callee using SMS to application server 11 as taught by Hyllander et al. The application server 11 then forwards the internet address of the received SMS to the coupled conference server 152. The conference server 152 responds by preparing a conference call connection and notifying the coupled application server 11 that the connection is prepared. The application server 11 then transmits a SMS that includes a temporary routing number associated with the requested call to the user terminals, thus allowing the user terminals to receive a temporary routing number for a conference call as recited by the independent claims.

The Applicant further argues that, "one of ordinary skill in the art would not be motivated to make the Hyllander and Chaney combination proposed by the Examiner. Applicants submit that Chaney teaches away because Chaney's conference service relies solely on packet-switched approaches and the PIM server and thus would not be operative with circuit-switched users." In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the application server 11 as taught by Hyllander et al. is capable of communicating with both a circuit switched network and packet switched network (see figure 2). In fact, Hyllander et al. suggests that the application server 11 allows a mobile user to make an Internet telephone call (see Hyllander et al., column 2 lines 31-38). Such an Internet telephone call is analogous to the Internet telephone calls provided by conference server 152 as taught by Chaney et al. The conference server 152 as taught by Chaney et al. simply needs the Internet address of the desired callee to establish a conference. This internet address can be provided by Application Server 11 which receives the Internet address of the desired callee via SMS. Once the SMS is received, the application server can forward to the internet address to the coupled conference server 152.

For at least the reasons explained in this form, the request for reconsideration has been considered by does not place the application in condition for allowance.